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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 10/054,486 | 01/22/2002 | William A. Whittenberger | 555-01 | 5581 |

2746 7590 08/22/2005

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EXAMINER

COMPTON, ERIC B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3726

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/054,486 | Applicant(s) WHITTENBERGER, WILLIAM A. | |
| | Examiner Eric B. Compton | Art Unit 3726 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,10 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7,8,10 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/22/09</u> | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 7-8, 10, and 14-16 in the reply filed on May 4, 2005, is acknowledged.
2. Claims 1-6, 9, and 11-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Objections

3. Claim 14 is objected to because of the following informalities: in line 3 the limitation "some of the strips are displaced relative to others of the strips" is ambiguous since it is not known whether Applicant's intend "some of the strips to include" "the flat" or "the corrugated" or both. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

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application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated U.S. Pat. 6,403,039 to Bruck et al.

Bruck, Figures 4-8, discloses a catalytic combustor comprising a plurality of metal strips assembled in a stack, some flat and some corrugated, wherein the stack has end faces, wherein some of the strips are displaced relative to others of the strips, such that some of the strips do not terminate at the end faces, wherein the strips are welded together to form a unitary structure.

"[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

6. Claims 7-8, 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated U.S. Pat. 6,334,769 to Retallick et al.

Regarding claim 14, Retallick, Figure 3, discloses a catalytic combustor comprising a plurality of metal strips assembled in a stack, some flat and some corrugated, wherein the stack has end faces, wherein some of the strips are displaced relative to others of the strips, such that some of the strips do not terminate at the end faces, wherein the strips are welded together to form a unitary structure.

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Regarding claims 7-8 and 15, as shown in Figure 3, the flat strips (20) alternate with the corrugated strips (21) in the stack, and wherein flat strips and corrugated strips are alternatively displaced in the stack. Notice the flat strips extend past the corrugated strips, left-to-right, in an alternating manner between layers.

Regarding claims 10 and 16, as shown in Figure 3, some of the corrugated strips have low-amplitude corrugations (22) and some of the corrugated strips have high-amplitude corrugations (21), and wherein the low-amplitude corrugated strips are displaced such that the low-amplitude corrugated strips (22) do not terminate at the end face. Also, it can be seen the ends of the low-amplitude corrugated strips (22) on the left are recessed with respect to the other two strips.

"[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

7. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated U.S. Pat. 5,672,324 to Okamoto et al.

Okamoto, Figure 6, discloses a catalytic combustor comprising a plurality of metal strips assembled in a stack, some flat and some corrugated, wherein the

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stack has end faces, wherein some of the strips are displaced relative to others of the strips, such that some of the strips do not terminate at the end faces, wherein the strips are welded together to form a unitary structure.

"[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David p. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric B. Compton
Primary Examiner
Art Unit 3726

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